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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,374

Applicant(s)

TENORIO, MANOEL

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the response filed on 29 August 2005.
2. Claims 1-34 have been examined.

RESPONSE TO ARGUMENTS

3. Applicant's arguments received on 29 August 2005 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claim 1, Applicant argues that the prior art of record, taken individually or in combination, does not fully disclose the limitations of the instant invention. The Examiner respectfully disagrees. It appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a). Applicant argues that there is no motivation to combine the applied references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. Although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Within *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective references which specifically support that particular motivation. As such, it is NOT seen that the Examiner's

combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex pane Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Applicant argues that a *prima facie* case of obviousness has apparently not been established. In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has successfully been satisfied, since evidence of corresponding claim elements in the prior art has been presented, and since the Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivations explicitly stated in the paragraphs below.

With regard to claims 6, 8, 14, 22-24, and 30, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Applicant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion of should be included.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman et al, U.S. Patent No. 6,038,668 in view of Hokanson, U.S. Patent No. 6,094,680 and Zhao, U.S. Patent No. 6,081,840.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified Citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claims 1, 15, 17 and 31:

Chipman et al disclose a method and software for migrating product data within an electronic commerce system, comprising:

- monitoring requests for product data by users of a global content directory (Col. 3, lines 55-60; Col. 4, lines 35-40; Col. 5, lines 24-30; Col. 7, lines 30-45), the global content directory comprising:

- a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class (Col. 3, lines 30-50; Col. 4, lines 35-40; Col. 6, lines 58-64; Col. 7, lines 39-58); and
- one or more pointers associated with each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products associated with the product class (Col. 5, lines 24-30; Col. 9 line 63-Col. 10 line 9);

Chipman et al further discloses creating a searchable directory structure on a portal which acts as a primary interface to the organized information and further wherein the portal is remote from the sellers/suppliers more detailed database of product information. Although Chipman et al discloses the migration of this directory structure to a storage location remote from the seller, Chipman et al fails to explicitly disclose that this migration occurs based upon monitoring requests by the user and initiating the migration of the product data from the seller database to the storage location. Hokanson discloses a system for managing distributed resources on networks and teaches the use of multiple network cites for facilitating user access to information. Users can locally access certain resources at a local network cite to which they are connected, or remotely access other resources at remote network cites. The network manager manages the location of resources among the network cites to make the resources available to the users given their request patterns. The network manager weighs the cost of relocating the requested resource to the local network cite closer to the user (Col. 2, lines 35-61). Hokanson identifies locations of particular users, such as which city they may be located in (Figure 1; Col. 4, lines 30-54), and monitors the user demand for resources and dynamically adjusts the resource offerings to better service the user's requests by relocating the requested resource information to a location physically closer to the user (Col. 6, lines 35-45; Col. 6 line 62-Col. 7 line 7; Col. 7, lines 25-67; Col. 9, lines 47-54). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman et al and include the ability to migrate product data from sellers databases to

storage locations closer to the user that requested the information as taught by Hokanson. Hokanson focuses on monitoring requests from groups of users located in a particular location and relocating frequently requested information physically closer to the users , however, examiner submits that one having ordinary skill in the art would readily recognize that this technique may be used for single users rather than a group of users. Chipman provides motivation by suggesting that moving or locating high level descriptive information to a location more local to the user would facilitate quick access to the variety of information stored locally (Col. 3, lines 55-60). Similarly, Hokanson discloses that locating frequently access resource information to a location physically closer to the user would more efficiently meet user demand by making the resources available within acceptable time frames while satisfying the desire to contain costs (Col. 2, lines 5-10; Col. 6, lines 40-45).

Chipman et al further fail to explicitly disclose generating a request history for each of the users based on the monitoring of the requests for product data by the users. Hokanson identifies locations of particular users, such as which city they may be located in (Figure 1; Col. 4, lines 30-54), and monitors the user demand for resources and dynamically adjusts the resource offerings to better service the user's requests by relocating the requested resource information to a location physically closer to the user (Col. 6, lines 35-45; Col. 6 line 62-Col. 7 line 7; Col. 7, lines 25-67; Col. 9, lines 47-54). Zhao discloses a content distribution system and teaches a method for monitoring the usage patterns of data used by the users and determines whether or not the data should be migrated to a location more local to the user (Col. 3, lines 5-18; Col. 4, lines 45-60). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman et al and include generating request histories for each user based on the teachings of Hokanson and Zhao. The same motivation discussed above applies. Zhao also provides motivation by indicating that monitoring user requests of data and subsequently moving data that is requested more to a location physically closer to the user would enable the local servers to handle most file requests without the need to contact the source server and reduce the communications overhead resulting in such contacts (Col. 4, lines 53-60).

Claims 2 and 18:

Chipman et al further disclose wherein a request for product data by a user comprises a selection of a product from search results obtained from one or more seller databases by the global content directory and communicated to the user (Col. 4, lines 35-40; Col. 5, lines 55-62; Col. 7, lines 30-65).

Claims 3, 10-12, 19, and 26-28:

Chipman et al fails to disclose determining that the user has requested the information a selected number of times within a selected period of time and determining if the information should be migrated based on this. Hokanson discloses relocating the information closer to the user based upon monitoring user demand for the requested resource information (Col. 2, lines 45-50; Col. 5, lines 17-20; Col. 6, lines 35-45). Hokanson does not explicitly state determining that the user has requested the information a selected number of times within a selected period of time, however, examiner submits that this is a well known technique for measuring user demand. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman and relocate data physically closer to the user based on certain user demand measurements such as the number of times the information is requested within a selected period of time in order to better serve the user.

Claims 4-5 and 20-21:

Chipman et al further discloses wherein the data that is migrated comprises product data associated with each of a plurality of products in a product class (Col. 3, lines 30-60; Col. 5, lines 55-62; Col. 9, lines 35-52; Col. 10 line 63-Col. 11 line 2).

Claims 6, 8 and 22-24:

Chipman et al and Humphrey fail to specifically disclose deleting or overwriting data with other data when the data has not been requested for a specified period of time or when the storage is needed for additional data. Examiner takes **Official Notice** that it is well known in the art to delete or overwrite

data that is determined to be no longer useful. The motivation to delete or overwrite data that is determined to no longer be useful would be to alleviate the wasting of storage space by freeing more storage space for information that is more active or popular and would obviously provide more benefit to the users that most likely would be interested in the more active or popular information.

Claims 9, 13, 25 and 29:

Chipman et al further disclose wherein migrated product data is stored for access by each of a subset of the users and the storage location for the product data is determined based on the locations of each of the subset of users (Col. 3, lines 57-60; Col. 5, lines 9-18).

Claims 14 and 30:

Chipman et al and Humphrey fail to disclose storing the product data inside a firewall of the computer. Examiner takes **Official Notice** that storing data within a user's firewall is well known in the art and the reasons for doing this are also well known. It is well known that a firewall provides a means for storing information within a computer in a secure manner that limits outsiders from accessing the data.

Claims 16 and 32:

Chipman et al further disclose creating pointers to the storage locations and to update the migrated product data using the pointer when the product data is updated in the seller database (Col. 35-53).

Claims 33 and 34:

Chipman et al disclose a method and software for migrating product data within an electronic commerce system, comprising:

- monitoring requests for product data by users of a global content directory, the requests each comprising a selection of a product from search results obtained from one or more seller databases by the global content directory and communicated to the

user (Col. 3, lines 55-60; Col. 4, lines 35-40; Col. 5, lines 24-30; Col. 7, lines 30-45), the global content directory comprising:

- a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class (Col. 3, lines 30-50; Col. 4, lines 35-40; Col. 6, lines 58-64; Col. 7, lines 39-58); and
- one or more pointers associated with each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products associated with the product class (Col. 5, lines 24-30; Col. 9 line 63-Col. 10 line 9);

Chipman et al further discloses creating a searchable directory structure on a portal which acts as a primary interface to the organized information and further wherein the portal is remote from the sellers/suppliers more detailed database of product information. Although Chipman et al discloses the migration of this directory structure to a storage location remote from the seller and further teaches updating the migrated data using pointers when the product data is updated in the seller database (Col. 35-53), Chipman et al fail to explicitly disclose that this migration occurs based upon monitoring requests by the user and initiating the migration of the product data from the seller database to the storage location based upon the number of times the user has requested the information. Hokanson discloses a system for managing distributed resources on networks and teaches the use of multiple network cites for facilitating user access to information. Users can locally access certain resources at a local network cite to which they are connected, or remotely access other resources at remote network cites. The network manager manages the location of resources among the network cites to make the resources available to the users given their request patterns. The network manager weighs the cost of relocating the requested resource to the local network cite closer to the user (Col. 2, lines 35-61). Hokanson identifies locations of particular users, such as which city they may be located in (Figure 1; Col. 4, lines 30-54), and monitors the user demand for resources and dynamically adjusts the resource offerings to

better service the users requests by relocating the requested resource information to a location physically closer to the user (Col. 6, lines 35-45; Col. 6 line 62-Col. 7 line 7; Col. 7, lines 25-67; Col. 9, lines 47-54). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman et al and include the ability to migrate product data from sellers databases to storage locations closer to the user that requested the information as taught by Hokanson. Hokanson focuses on monitoring requests from groups of users located in a particular location and relocating frequently requested information physically closer to the users, however, examiner submits that one having ordinary skill in the art would readily recognize that this technique may be used for single users rather than a group of users. Chipman provides motivation by suggesting that moving or locating high level descriptive information to a location more local to the user would facilitate quick access to the variety of information stored locally (Col. 3, lines 55-60). Similarly, Hokanson discloses that locating frequently access resource information to a location physically closer to the user would more efficiently meet user demand by making the resources available within acceptable time frames while satisfying the desire to contain costs (Col. 2, lines 5-10; Col. 6, lines 40-45).

Chipman et al further fail to explicitly disclose generating a request history for each of the users based on the monitoring of the requests for product data by the users. Hokanson identifies locations of particular users, such as which city they may be located in (Figure 1; Col. 4, lines 30-54), and monitors the user demand for resources and dynamically adjusts the resource offerings to better service the users requests by relocating the requested resource information to a location physically closer to the user (Col. 6, lines 35-45; Col. 6 line 62-Col. 7 line 7; Col. 7, lines 25-67; Col. 9, lines 47-54). Zhao discloses a content distribution system and teaches a method for monitoring the usage patterns of data used by the users and determines whether or not the data should be migrated to a location more local to the user (Col. 3, lines 5-18; Col. 4, lines 45-60). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman et al and include generating request histories for each user based on the teachings of Hokanson and Zhao. The same motivation discussed above applies. Zhao also provides motivation by indicating that monitoring user requests of data and

subsequently moving data that is requested more to a location physically closer to the user would enable the local servers to handle most file requests without the need to contact the source server and reduce the communications overhead resulting in such contacts (Col. 4, lines 53-60).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

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571-273-8300 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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JAMES A. REAGAN

Primary Examiner

Art Unit 3621

14 November 2005

A handwritten signature in black ink, appearing to read 'James A. Reagan', with a long horizontal line extending to the right.